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10/083,000	02/26/2002	Paul M. Cosenza	12912-002001	4287

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EXAMINER

GOLBA, TARA M

ART UNIT	PAPER NUMBER
3644	

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/083,000	COSENZA, PAUL M.
	<b>Examiner</b>	<b>Art Unit</b>
	Tara M. Golba	3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-22 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-22 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. 
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4 and 5</u> .	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "W" has been used to designate both a waist opening and a width, and the character "T" has been used to designate both trousers and a thickness. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claims 1 and 4 are objected to because of the following informalities: In claim 1, line 2, "comprises" should be --comprising--. In claim 4, line 4, "a said second" should simply be --said second--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 uses the term "inner release sheet" to describe a release sheet mounted on both the first, inner adhesive layer and the second, outer adhesive layer. The term "*inner* release sheet" is therefore misleading because the release sheet is actually mounted on both inner and outer layers.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in–
  - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
  - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1, 5, 16, and 22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,353,939 to Arber (cited by applicant).

In reference to claim 1, Arber discloses a tick protection device comprising at least one protection element (figure 1, element 44), the protection element including: an elongate substrate with inner and outer surfaces; and respective inner and outer adhesive layers (column 5, line 36, where these features are inherent in double-sided tape). It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Here it is understood that the first adhesive layer is adapted to adhere the protection element upon a clothing surface near an opening (figure 1), and that the second adhesive layer is adapted to impede advancement of crawling insects (column 3, lines 20-22).

In reference to claim 5, Arber discloses multiple protection elements (figure 1, element 44 in two locations).

In reference to claim 16, Arber discloses the method of selecting a protection element with two adhesive layers (element 44); exposing the adhesive surface of the first adhesive layer

(inherent in the application of double-sided tape to a surface); applying the adhesive surface to a clothing surface (figure 1, element 44 applied to legging 10); and exposing the adhesive surface of the outer layer to impede advancement of insects (column 3, lines 20-24).

In reference to claim 22, Arber discloses the adherence of protection elements in regions of multiple clothing openings (figure 1, two leg regions).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-4, 6-9, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arber.

In reference to claim 2, Arber discloses a release sheet for the outer adhesive surface (column 3, lines 23-24) but does not specifically disclose a release sheet for the adhesive surface of the inner adhesive layer. Nevertheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include release sheets on both the inner and outer surfaces, since it has been held that mere duplication of the essential working parts of the device involves only routine skill in the art.

In reference to claim 3, Arber discloses an outer release sheet. See discussion of claim 2 above.

In reference to claim 4, and as the claim is best understood, Arber discloses a release sheet on the outer adhesive surface (column 3, lines 23-24). It would have been obvious to

include a release sheet mounted upon the adhesive surfaces of inner and outer adhesive layers, since it has been held that mere duplication of the essential working parts of a device and rearranging parts of an invention involves only routine skill in the art.

In reference to claim 6, Arber discloses a protection element sized and configured for adhering upon a clothing surface in the region of pant cuffs (figure 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to also include protective elements in the region of the waist band, shirt collar, shirt front, and shirt sleeves, since it has been held that rearranging parts of an invention involves only routine skill in the art. It would have also been obvious to modify the size of the protective elements for their positioning in different regions because a change in size is recognized as being within the level of ordinary skill in the art.

In reference to claims 7-9, Arber discloses a protection element pre-configured for length and shape (figure 1, where element 44 has been designed to fit around the leg).

In reference to claim 17, Arber discloses adhering the protection element around the lower leg (figure 1) but does not specifically state that the element is adhered below clothing openings. Nevertheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to position the element below a clothing opening, since it has been held that rearranging parts of an invention involves only routine skill in the art.

In reference to claims 18 and 19, Arber teaches the claimed steps of removing inner and outer release sheets. See discussion of claims 2 and 3 above.

In reference to claim 20, Arber discloses delaying removal of the release sheet to expose the adhesive surface of the outer adhesive layer until protection is desired (column 5, lines 37-39, where the release sheet covers the adhesive prior to use).

In reference to claim 21, Arber teaches the claimed step of adhering the protection element in regions of various clothing openings. See discussion of claim 6 above.

9. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arber in view of U.S. Patent No. 2,911,756 to Geary.

In reference to claims 10 and 11, Arber does not specify that the protection element comes in roll or sheet form.

Geary teaches that an adhesive insect-capturing material can come in roll or sheet form because both forms are suitable for providing the material in pre-determined sizes (column 3, lines 41-47). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the protection element disclosed by Arber in the sheet or roll taught by Geary, since both forms are suitable for providing a pre-configured element.

10. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arber in view of U.S. Patent No. 5,381,557 to Luria et al.

In reference to claim 12, Arber does not disclose the claimed shield.

Luria et al. teaches a shield portion (figure 1, element 13) extending outwardly from a plane of a substrate relative to and above a second, outer adhesive layer (element 2). Luria teaches that the motivation for using the shield is to protect the adhesive by sheltering it (column 4, lines 65-66). Therefore, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to include an outwardly-extending shield, as taught by Luria, for the device disclosed by Arber, so as to protect the adhesive surface.

In reference to claim 13, Luria does not teach a shield portion integral with the substrate, but it would have been obvious to form the shield and substrate integrally since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

In reference to claim 14, Luria teaches a shield with the form of a curved outward extension of an edge portion of the substrate (figure 3). See discussion of claim 12 above.

In reference to claim 15, Luria teaches a shield comprising a protrusion (figure 3). See discussion of claim 12 above.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,249,310 to Forte

U.S. Patent No. 3,816,956 to Sekula

U.S. Patent No. 5,031,354 to Olson

U.S. Patent No. 5,253,448 to Byom

U.S. Patent No. 6,071,583 to Pomerantz

Japanese Patent Publication No. 2043278 to Sugano

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara M. Golba whose telephone number is (703) 305-0266. The examiner can normally be reached on Monday-Thursday from 8:00 A.M. to 5:00 P.M..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Jordan can be reached at (703) 306-4159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

*Charles T. Jordan*  
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tmg  
December 16, 2002